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EXAMINER

SULLIVAN, JULIANNE M

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,286	Applicant(s) KERSTEN ET AL.	
	Examiner Julianne M. Sullivan	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/11/02; 1/28/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

in the Brief Description of the Drawings, Figures 9A and 9B are identified; however, the in the Drawings, those figures are labeled 9 and 9A, respectively.

in the Detailed Description, page 7, lines 13, 15, 16 and 19, ref. no. 16 is used to identify both a "pole support" and a "plate."

Appropriate correction is required.

2. The use of the trademarks SUMMER SKY ENVELITE ® and VELCRO ® have been noted in this application. Each trademark should be fully capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

3. The attempt to incorporate subject matter into this application by reference to U.S. Patent Application No. 08/978,084 is improper because that application has been expressly abandoned. As an abandoned application, its disclosure is not available to the public; therefore it is not possible for the public to determine what subject matter Applicants intend to make a part of their disclosure. Appropriate correction is required.

Claim Objections

4. Claims 8 and 48 are objected to as failing to provide proper antecedent basis for the claimed subject matter. Claim 8 recites the limitation "the ceiling" in line 1 and Claim 48 recites the limitation "the ceiling" in line 2. There is insufficient antecedent basis for these limitations in the claims.

5. The following typographical error was noted in the Claims: in Claim 37, line 1, "a magnet resonance." Appropriate correction is suggested.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 18 of U.S. Patent No. 6,335,623 to Damadian et al. in view of Kormos et al. (U.S. Patent No. 6,198,285). Although the conflicting claims are not identical, they are not patentably distinct from one another because they are directed to the same decoration of poles within a magnetic resonance imaging room.

Damadian et al. claims all of the features of the present invention, including an MRI assembly comprising first and second opposed ferromagnetic elements, first and second ferromagnetic pole supports connected to the first and second ferromagnetic elements, first and second poles, and the decoration of those poles (col. 31, lines 29-32 and col. 32, lines 1-2 and 8-30), except for claiming a screen within the assembly having a plurality of images with means for changing the image. In the same field of endeavor, Kormos et al. provides an MRI assembly with a screen having multiple images and a means of changing the image (col. 3, lines 48-52 and 57-63 and col. 4, lines 32-36 and 49-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a screen within the assembly for the display of images to improve the patient's experience with the imaging procedure (see for motivation Damadian et al. at col. 29, lines 26-32).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 26 and 32 contain the trademark/trade name VELCRO ®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or

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product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain because the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe hook-and-loop fastener material and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 7, 35 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Kormos et al. (U.S. Patent No. 6,198,285).

Kormos et al. discloses a room for conducting a medical procedure having a magnetic resonance imaging assembly with first and second ferromagnetic elements, ferromagnetic pole supports, and poles supported by the pole supports, a screen within the assembly having a plurality of images, illumination from behind and means for changing the image to a selected image (col. 3, lines 48-52 and 57-63, col. 4, lines 32-36 and 49-56 and col. 5, lines 27-30). The Examiner has interpreted Claim 1, line 9 as means plus function language, thus invoking the

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sixth paragraph of 35 U.S.C. 112, and the Examiner has looked to the specification for a description of the structure claimed. Although Kormos et al. does not provide the exact structure described in the specification, it is a functional equivalent because it serves the same purpose of providing images within the magnet assembly and achieves the same result of changing the images displayed.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 4-6, 10-12, 14-17, 27, 34, 36-38, 40, 42-47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August (U.S. Patent No. 5,681,259).

Regarding Claims 2, 4-6, 10, 11, 36-38, 40, 42-47 and 49, Kormos et al. teaches all of the features of the present invention except the limitations of means for moving the screen, displaying a first or second selected image on the screen, a cartridge for containing the screen, means for changing the cartridge, an arcuate screen, an acoustic means and a scent means. In the same field of endeavor, August teaches each of these features, including means for moving the screen, displaying a first or second selected image on the screen, a cartridge for containing the screen and means for changing the cartridge (col. 10, lines 12-15 and 48-49 and col. 12, lines 20-34 and 47-48). Here, the Examiner has interpreted the screen of August to be capable of being arcuate because it is on a flexible fabric and may be positioned in the curved region of the curtain track (col. 8, lines 59-64 and Fig. 1), thus it meets the limitation of Claim 6 of an arcuate track.

Finally, August teaches both auditory and olfactory stimulation (col. 10, lines 56-65 and col. 11, lines 14-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the screen of August in the magnetic resonance imaging room of Kormos et al. in order to provide a soothing and relaxing effect for the patient and to ease the process of obtaining the MRI images (see August at col. 9, lines 32-38).

Regarding Claims 12, 14-17, 27 and 34, Kormos et al. teaches all of the features of the present invention, including a bed for supporting a patient (col. 4, line 36 and ref. no. 16 in Fig. 1), except for expressly disclosing means for moving the screen to display an image, a moving means that is a belt to which the screen is removably attached, a track for guiding the belt and an arcuate track. In the same field of endeavor, August teaches means for moving the screen to display an image, a moving means that is a belt to which the screen is removably attached, a track for guiding the belt and an arcuate track (col. 10, lines 12-15 and 30-32 and col. 12, lines 3-8). Here the Examiner has interpreted the curtain (ref. no. 28 in Fig. 1) as the belt to which the screen is removably attached and the curtain rod (unnumbered in Fig. 1) as the track by which the belt is guided, which is arcuate in the regions where it rounds the corners of the room (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the screen and system of August with the MRI apparatus of Kormos et al. for the reasons stated above.

14. Claims 3, 18, 20, 22-26, 28-33, 50, 51 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August as applied to Claims 1, 12 and 37 above, and further in view of Simson et al. (U.S. Patent No. 5,953,840).

Regarding Claims 3 and 18, Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing that a switch is used to control the movement of the screen and that a pulley system and motor are used. In a related field of endeavor, Simson et al. discloses a switch that is used to control movement of a screen for displaying an image (col. 4, lines 23-25 and col. 13, lines 42-43) and a pulley system and motor (col. 4, lines 19-22 and col. 7, lines 11-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the switch, pulley system and motor of Simson et al. to a movable screen in order to move the screen without requiring the physical effort of pulling the screen into place.

Regarding Claim 20, Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing a take-up cartridge for winding the screen during display of an image. In a related field of endeavor, Simson et al. teaches a system with delivery and take-up cartridges where the screen is unwound from one and wound onto the other (col. 5, lines 27-36, col. 7, lines 52-55 and col. 8, lines 33-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a second cartridge with a moveable screen in order to make use of and to store a larger screen where the display area was shorter than the screen.

Regarding Claims 22-26, 28-33, 50, 51 and 54, Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing a motor coupled to the belt to move the belt within the track across the room, where there is a serrated gear couple to the belt that has a serrated portion, and a pulley and torque converter for controlling the movement, where movement of the belt causes movement of the screen into or out of the cartridge. In a

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related field of endeavor, Simson et al. teaches a motor coupled to a belt that moves the belt within its track, a belt and pulley system that may be serrated, and a torque converter, which system causes movement of the screen into and out of the cartridge (col. 4, lines 19-22 and col. 7, lines 5-6, 11-23 and 52-55 and col. 8, lines 33-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coupled the pulley system and motor of Simson et al. to a belt within a track having a movable screen in order to move the screen without requiring the physical effort of pulling the screen into place.

15. Claims 8 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August as applied to Claims 1 and 37 above, and further in view of Overweg (U.S. Patent No. 5,917,395).

Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing a ceiling that is illuminated. In the same field of endeavor, Overweg teaches an MRI system having ceiling-mounted illumination (col. 3, lines 5-9 and col. 4, lines 27-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide lighting on the ceiling of the room so that the room is adequately lit for movement within the room and viewing of the screen.

16. Claim 9 is rejected under 35 U.S.C. 103(a) as being obvious over Kormos et al. in view of Damadian et al. (U.S. Patent No. 6,335,623).

The applied reference has a common assignee and one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by:

(1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference

was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Kormos et al. teaches all of the features of the present invention except for expressly disclosing that the poles of the apparatus are decorated. In the same field of endeavor, Damadian et al. teaches an MRI apparatus having walls and poles decorated with outdoor scenes (col. 3, line 67, col. 4, lines 1-9, col. 29, lines 2-20 and Fig. 22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have decorated the poles in the apparatus of Kormos et al. in the manner of Damadian et al. in order to lessen the claustrophobic effect of the magnet apparatus (see for motivation Damadian et al. at col. 4, lines 8-9).

17. Claims 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August as applied to Claim 12 above, and further in view of Saylor et al. (U.S. Patent No. 4,173,087).

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Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing that the screen is printed on both sides and that the screen is movable to display the image on the front side or the back side. In a related field of endeavor, Saylor et al. teaches a system using a scroll-style display where the screen is printed on both sides (col. 1, lines 53-62 and col. 2, lines 49-52) and where rollers are set up such that the screen moves around the rollers to display the images on the front and the back sides (col. 2, lines 52-57 and col. 4, lines 30-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a two-sided screen and system displaying images on either side of Saylor et al. with the display apparatus of Kormos et al. and August in order to shorten the length of screen needed to provide the number of images desired and to increase the efficiency of the system by reducing the length of time it takes to switch from an image at one end of the screen to one at the other end (see Saylor et al. at col. 1, lines 35-40).

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August as applied to Claim 12 above, and further in view of Vinegar et al. (U.S. Patent No. 4,651,099).

Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing a window for viewing an image on the screen from the exterior of the room. In the same field of endeavor, Vinegar et al. teaches an MRI scan room having a window for viewing activities inside the room from the exterior (col. 5, lines 1-7, col. 6, lines 45-53 and Fig. 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to have placed a window in the room of Kormos et al. in order to allow the patient inside to look

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out and those outside to view the inside of the room (see for motivation Vinegar et al. at col. 6, lines 45-47).

19. Claims 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August as applied to Claim 40 above, and further in view of Sahadevan (U.S. Patent No. 5,842,987).

Kormos et al. in view of August teaches all of the features of the present invention except for expressly disclosing that a second patient is introduced into the MRI assembly and a second imaging procedure is performed. In the same field of endeavor, Sahadevan teaches an MRI system designed to increase patient throughput such that imaging is performed on a second patient with minimal delay between patients (col. 1, lines 25-28, col. 2, lines 62-67 and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to place a second patient into the MRI apparatus and perform an additional scan in order to maximize the efficiency of the system and because it is customary for scanning procedures to be performed on multiple patients each day (see for motivation Sahadevan at col. 1, lines 19-30 and 36-42).

20. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kormos et al. in view of August, and further in view of Simson et al. as applied to Claim 22 above, and further in view of Overweg.

Kormos et al. in view of August, and further in view of Simson et al., teaches all of the features of the present invention except for expressly disclosing a ceiling that is illuminated. In the same field of endeavor, Overweg teaches an MRI system having ceiling-mounted illumination (col. 3, lines 5-9 and col. 4, lines 27-30). It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to provide lighting on the ceiling of the room so that the room is adequately lit for movement within the room and viewing of the screen.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. August (U.S. Patent No. 6,503,188) discloses a related rolling screen for use in a medical facility. Heck et al. (U.S. Patent No. 2,377,553) and Morrone (U.S. Patent No. 1,196,136) disclose related reversible scrolling display devices.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julianne M. Sullivan whose telephone number is 571-272-6084. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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